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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,134	08/23/2001	Joseph E. Hooten	5008-0002	1714
7590		03/02/2006	EXAMINER	
Michael L. Diaz		KOPPIKAR, VIVEK D		
Michael L. Diaz, P.C.		ART UNIT		
555 Republic Drive, Suite 200		PAPER NUMBER		
Plano, TX 75074		3626		

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/938,134	<b>Applicant(s)</b> HOOTEN, JOSEPH E.	
	<b>Examiner</b> Vivek D. Koppikar	<b>Art Unit</b> 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 August 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/23/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of the Application***

1. Claims 1-24 have been examined in this application. As of the date of this communication, the applicants have not filed an Information Disclosure Statement (IDS) statement for this case.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 13-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In line 3 of claim 13 and lines 7 and 10 of claim 24, the step “inflecting the computer by a computer virus” renders the claim indefinite. The claim, as written, implies that the user inflects the computer by a computer virus. The examiner interprets this phrase as meaning that the computer is inadvertently inflected by a computer virus and this is not a result of the user’s actions. The examiner recommends amending the above mentioned claims to clarify this language so that the claim clearly conveys that the virus is inadvertently inflected with a computer virus and it is not a result of any actions on the part of the user of the computer system.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-22 and 24 are rejected under 35 U.S.C. 102(b) as being unpatentable by "Viruses and Forged Faxes Now Get Insurance Protection" published in Newsbytes on February 19, 1991 (hereinafter referred to as "Newsbytes").

(A) As per claim 1, Newsbytes teaches a system for insuring a customer having a computer against damage caused by a computer virus (Newsbytes: Paragraph 1), said system comprising:

a computer (Newsbytes: Paragraph 1);

an insurer providing insurance coverage against computer virus infection of said computer (Newsbytes: Paragraphs 1 and 6); and

means for compensating the customer if said computer becomes infected with a computer virus (Newsbytes: Paragraphs 1 and 6);

wherein said insurer provides compensation to the customer when said computer becomes infected with the virus (Newsbytes: Paragraphs 1 and 6-7).

(B) As per claim 2, in Newsbytes the computer virus causes damages to at least one software program installed in said computer (Newsbytes: Paragraphs 6-7).

(C) As per claim 3, in Newsbytes the compensating means includes providing the customer with a monetary compensation to replace the installed software program (Newsbytes: Paragraphs 1 and 6-7).

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(D) As per claim 4, in Newsbytes the compensating means includes replacing the installed software program with a comparable software program (Newsbytes: Paragraphs 1 and 6-7).

(E) As per claim 5, in Newsbytes the compensating means includes repairing the installed software program (Newsbytes: Paragraphs 1 and 6-7).

(F) As per claim 6, in Newsbytes the computer includes at least one computer component and the computer virus causes damage to at least one hardware component of said computer (Newsbytes: Paragraph 1 and 6-7).

(G) As per claim 7, in Newsbytes the compensating means includes providing the customer with a monetary award to replace the damaged computer component (Newsbytes: Paragraphs 6-7).

(H) As per claim 8, in Newsbytes the compensating means includes replacing the damaged computer component (Newsbytes: Paragraph 6).

(I) As per claim 9, in Newsbytes the compensating means includes repairing the damaged computer component (Newsbytes: Paragraph 6).

(J) As per claim 10, in Newsbytes the insurer requires a fulfillment of at least one prerequisite by the customer to provide compensating means to the customer (Newsbytes: Paragraph 7).

(K) As per claim 11, in Newsbytes at least one prerequisite includes installing an anti-virus software program in said computer (Newsbytes: Paragraph 7).

(L) As per claim 12, Newsbytes teaches a method of insuring a customer having a computer for damage caused by a computer virus, said method comprising the steps of:

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offering, by an insurer, coverage of a computer for damage caused by a computer virus to the customer; selecting, by the customer, coverage offered by the insurer; and buying, by the customer, offered coverage (Newsbytes: Paragraphs 1-6 and 7).

(M) As per claim 13, Newsbytes further comprising, after the step of buying coverage, the steps of:

infecting the computer by a computer virus (Paragraphs 1 and 6-7);

requesting compensation by the customer for damage caused by the computer virus

(Paragraph 1 and 6-7); and

providing compensation by the insurer to the customer for damage caused by the computer virus (Newsbytes: Paragraphs 6 and 7)

(N) As per claim 14, in Newsbytes the step of providing compensation to the customer includes repairing the damaged computer (Newsbytes: Paragraph 6).

(O) As per claim 15, in Newsbytes the step of repairing the damaged computer includes repairing computer software installed in the computer (Newsbytes: Paragraph 6).

(P) As per claim 16, in Newsbytes the step of repairing the damaged computer includes repairing a damaged computer component of the computer (Newsbytes: Paragraph 6).

(Q) As per claim 17, in Newsbytes the step of providing compensation to the customer includes providing monetary compensation to the customer for damage caused by the computer virus (Newsbytes: Paragraph 6).

(R) As per claim 18, in Newsbytes the step of providing compensation to the customer includes providing a replacement software program to replace damaged installed software caused by the computer virus (Newsbytes: Paragraph 6).

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(S) As per claim 19, in Newsbytes the step of providing compensation to the customer includes providing a replacement computer component to replace a damaged computer component caused by the computer virus (Newsbytes: Paragraph 6).

(T) As per claim 20, in Newsbytes the step of providing compensation to the customer includes providing a monetary fee to the customer for lost earnings caused by loss or degradation of performance of the computer (Newsbytes: Paragraphs 1 and 6).

(U) As per claim 21, in Newsbytes the step of offering coverage to the customer includes requiring the customer to fulfill at least one prerequisite to be covered in the event of damage caused by the computer virus (Newsbytes: Paragraph 7).

(V) As per claim 22, in Newsbytes the step of requiring the customer to fulfill at least one prerequisite includes requiring the installation of an anti-virus software (Newsbytes: Paragraph 7).

(W) As per claim 24, Newsbytes teaches method of insuring a customer having a computer for damage caused by a computer virus (Newsbytes: Paragraph 1), said method comprising the steps of:

offering, by an insurer, coverage of a computer for damage caused by a computer virus to the customer (Newsbytes: Paragraph 1);

selecting, by the customer, coverage offered by the insurer (Newsbytes: Paragraph 1);

buying, by the customer, offered coverage (Newsbytes: Paragraph 1);

infecting the computer by a computer virus (Newsbytes: Paragraph 6);

requiring the customer to fulfill at least one prerequisite to be covered in the event of damage caused by the computer virus (Newsbytes: Paragraph 7);

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infecting the computer by a computer virus (Newsbytes: Paragraphs 1 and 6);  
requesting compensation by the customer for damage caused by the computer virus (Newsbytes: Paragraphs 1 and 6); and  
providing compensation by the insurer to the customer for damage caused by the computer virus (Newsbytes: Paragraphs 1 and 6).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Newsbytes as applied to Claim 21 above.

(A) As per claim 23, Newsbytes does not teach or suggest that the step of requiring the customer to fulfill at least one prerequisite includes providing the insurer with a list of programs installed in the computer, however, the Examiner takes Official Notice that this feature is well known in the insurance industry. In the insurance industry it is common for the insurance company to require that the insured takes an inventory of all items that are being insured, for example, when an insured is purchasing a home owner's policy they must make an inventory list of all valuable belongs stored in their home. The claimed feature is identical to the feature in Claim 23. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have included this feature



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in Newsbytes for the motivation of providing the insurance company with a means of assessing and estimating both the frequency and magnitude of claims by the insured (which is the purpose served by requiring the insured to make these lists in the insurance industry).

### *Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent Number 6,487,558 to Hitchcock teaches a method for generating database server configuration documentation.

US Patent Application Publication 2002/0026335 to Honda teaches a data security insurance system.

9. Any inquire concerning this communication or earlier communications from the examiner should be directed to Vivek Koppikar, whose telephone number is (571) 272-5109. The examiner can normally be reached from Monday to Friday between 8 AM and 4:30 PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. The fax telephone number for this group is (703) 305-7687 (for official communications including After Final communications labeled "Box AF").

Another resource that is available to applicants is the Patent Application Information Retrieval (PAIR). Information regarding the status of an application can be

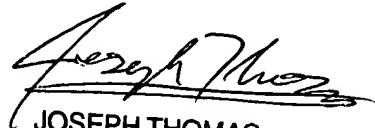
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obtained from the (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAX. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please feel free to contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,

  
Vivek Koppikar

12/6/2005

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER